

Remarks

The Final Office Action dated March 29, 2010, has been carefully considered. Applicant has amended claims 21 and 22 without the addition of new matter. Reconsideration of the claims is respectfully requested.

Claim Rejections – 35 USC § 112

In Paragraph 3 of the Office Action, claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Applicants have amended claim 21. In light of the amendment, Applicants respectfully submit the rejection is now moot. Applicants respectfully request the examiner withdraw the rejection to claim 21.

In Paragraph 5 of the Office Action, claims 21-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants have amended claims 21 and 22. In light of the amendments, Applicants respectfully submit the rejection is now moot. Applicants respectfully request the examiner withdraw the rejection to claims 21 and 22.

Information Disclosure Statement

The Attorney for Applicant acknowledges paragraph 8 of the Office Action and the status of the Information Disclosure Statement filed 08/24/06, and that this IDS has been placed in the file, but has not been considered. Abeyance is requested on this matter until a concise explanation can be provided.

Claim Rejections – 35 USC § 103

In Paragraph 11 of the Office Action, claims 1-5, 8, and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as ‘069) in view of Worschech et al. (4,637,887) (referred to as ‘887). In Paragraph 11, the Office Action references the rejection of claims 21, 23, and 24. Applicants request the following arguments be applied to claims 21, 23 and 24 in addition to claims 1-5, 8 and 14-18 even though claims 21, 23 and 24 are not enumerated in the list of claims rejected in Paragraph 11.

On page 4, Paragraph 11, of the Office Action, it is set forth that cotton seed oil fulfills the feature “at least one natural oil or fat” since the cotton seed oil “will intrinsically possess an iodine number overlapping the claimed ranges”. However, cotton seed oil does not intrinsically possess an iodine number overlapping the claimed ranges of below 10, but cotton seed oil has an iodine value of from about 103 to about 111. Based on this, the ‘069 patent fails to disclose the at least one natural oil or fat as set forth in the current claims.

In addition, one skilled in the art would read the ‘069 patent as teaching to use a natural oil or fat having an iodine value of about 103 to about 111, or a natural oil or fat having a iodine value much greater than 10. Hence, the ‘069 teaches away from using a natural oil or fat having an iodine value below 10 as set forth in the current claims. It is set forth in the MPEP 2141.02 and MPEP 2145 that when a reference teaches away from the present invention, it is improper to combine the reference with another reference to show the present invention. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught

the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.).

On page 5 of the Office Action, reference is made to hardened castor oil. Hardened castor oil does not meet the requirements of the feature “at least one natural oil.” Hardening is a treatment of the natural oil which clearly changes its properties and appearance by means of converting double bonds to single bonds by hydrogenation. Again, also in this respect, the ‘069 patent clearly does not disclose the elements of the present invention and teaches away from the current claims.

In summary, the ‘069 patent neither discloses or suggests to use natural fats and/or oil with an iodine value below 10 in a lubricant composition. In fact, the ‘069 patent clearly teaches to not use such oils or fats. Hence, the ‘069 patent teaches away from the claimed subject matter of the present invention and hence, it is improper to combine the ‘069 reference with the ‘887 patent as set forth in the Office Action.

The rejection in paragraph 11 of the Office Action is made in view of the ‘887 patent. As set forth above, it is improper to combine references where the references teach away from their combination. The ‘887 patent is cited for the disclosure of a hydroxyl fatty acid residue formed from rapeseed oil as it has an iodine number less than or equal to 5. It appears that it has been overlooked that these oils are used as a starting material for 2 reactions, first an epoxidation and second a hydrogenation in order to convert the double bonds of the oils into OH groups (C1, L53-58). Accordingly, the ‘887 patent teaches away from the concept of the present invention to provide a lubricant employing natural oils and fats as one component of the lubricant. The ‘887 patent does not cure the deficiency of the ‘069 patent. Neither Worschech ‘069 nor Worschech ‘887 alone or in combination, teach, suggest, or disclose the current

invention. In light of the amendments and above arguments, Applicants respectfully request the examiner withdraw the rejection of claims 1-5, 8, 14-18, 21, 23 and 24.

In Paragraph 12 of the Office Action, claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as '069) in view of Worschech et al. (4,637,887) (referred to as '887) as applied to claim 1 above, and further in view of Alastalo et al. (US 2005/0009957 A1). Applicant hereby incorporates the above arguments. Alastalo et al. does not cure the deficiencies of Worschech '069 and/or Worschech '887. None of Worschech '069, Worschech '887 or Alastalo et al., alone or in combination, discloses the current invention. In light of the amendments and the above arguments, Applicants respectfully request the examiner withdraw the rejection of claim 22.

In Paragraph 13 of the Office Action, claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as '069) in view of Worschech et al. (4,637,887) (referred to as '887) as applied to claim 1 above, and further in view of Haack et al. (US 5,889,102). Applicant hereby incorporates the above arguments. Haack et al. does not cure the deficiencies of Worschech '069 and/or Worschech '887. None of Worschech '069, Worschech '887 or Haack et al., alone or in combination, discloses the current invention. In light of the amendments and the above arguments, Applicants respectfully request the examiner withdraw the rejection of claim 9.

In Paragraph 14 of the Office Action, claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as '069) in view of Worschech et al. (4,637,887) (referred to as '887) as applied to claim 1 above, and further in

view of Dohi et al. (US 2004/0014861 A1). Applicant hereby incorporates the above arguments. Dohi et al. does not cure the deficiencies of Worschech '069 and/or Worschech '887. None of Worschech '069, Worschech '887 or Dohi et al., alone or in combination, discloses the current invention. In light of the amendments and the above arguments, Applicants respectfully request the examiner withdraw the rejection of claim 10.

In Paragraph 15 of the Office Action, claims 7, 11-13, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Worschech et al. (US 3,875,069) (referred to as '069) in view of Worschech et al. (4,637,887) (referred to as '887) as applied to claims 1 and 16 above, in view of Dohi et al. (US 2004/0014861 A1) as applied to claim 10, in view of Haack et al. (US 5,889,102) as applied to claim 9 and further in view of Lindner (US 6,818,689). Applicant hereby incorporates the above arguments. None of Dohi et al., Haack et al, or Lindner, alone or in combination, cure the deficiencies of Worschech '069 and/or Worschech '887. None of Worschech '069, Worschech '887, Dohi et al., Haack et al, or Lindner, alone or in combination, disclose the current invention. In light of the amendments and the above arguments, Applicant respectfully requests the examiner withdraw the rejection of claims 7, 11-13, and 19.

Conclusion

In view of the amendments and remarks presented herein, Applicant submits that the present application is in condition for allowance, and such action is respectfully requested. If, however, any issues remain unresolved, the Examiner is invited to telephone Applicant's counsel at the number provided below.

Respectfully submitted,

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